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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/552,025
Filing Date: July 28, 2006
Appellant(s): HORENTRUP ET AL.

Reitseng Lin
Registration No. 42,804
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/13/2009 appealing from the Office action

mailed 2/19/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing

on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

    a. Piroumian, V. "Java GUI Development, the Authoritative Solution"

       Copyright (c) 1999 by Sams Publishing

b. jlGui, Java Music Player, version 2.1.1, April 1, 2002;

http://web.archive.org.web/20021012174158/www.javazoom.net/jlgui/sour

ces.html

c. Java API, Java 2 Platform, Standard Edition, v1.2.2 API Specification:

Class JComponent, pages 1-42

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-11, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated

by Piroumian (Vartan Piroumian, Java™ GUI Development, the Authoritative Solution,

Copyright (c) 1999 by Sams Publishing.)

Claim 1, 2: Piroumian discloses a method for decoding (mapping from Java Program to

AWT, to Java VM, to Native System Libraries, to Window Manager, to Display; Fig. 2.1

page 19) a menu data segment, the method comprising the steps of

a. detecting within the menu data segment (program application logic, pg. 12), data

    corresponding to a plurality of menu items belonging to a menu page (pg. 12,

    components, such as the JMenu, pg. 229 and JMenuItem, pg. 232);

b. extracting from the menu data segment for each menu item of the plurality of

    menu items at least first data defining whether the menu item is selectable (pg.

    232: setEnabled) and second data defining whether the menu item has graphic

    representation data associated (JMenuItem(Icon icon), pg. 232);

c. decoding data corresponding to first menu items to selectable display data (fig.

    7.15, pg. 228), wherein the first menu items are menu buttons (pg. 228, 229,

    JRadioButtonMenuItem) and have graphic representation data associated (Fig.

    7.15);

d. decoding data corresponding to second menu items to non-selectable and visible

    display data, wherein the second menu items have graphic representation data

    associated (pg. 227, menu1.addSeparator(); Fig. 7.15); and

e. decoding data corresponding to third menu items to selectable and invisible

    menu elements (pg. 232, JMenuItem(), "No-arg constructor. It creates a menu

    item with no defined text or icon), wherein the third menu items have no

    associated graphic representation data, and wherein the third menu items are

    menu buttons that are automatically activated upon selection (pg. 232, void

    setAccelerator(KeyStroke keystroke), "Set the KeyStroke object that represetnt

    the key combination which selects the menu item.)

Claim 8: <u>Piroumian</u> discloses the method according to claim 1, wherein the first and the

second menu items have associated display positions comprising a horizontal address

and a vertical address (inherent feature as indicated by: page 2 of 42:

"BOTTOM_ALIGNMENT, CENTER_ALIGNMENT, LEFT ALIGNMENT, RIGHT

ALIGNMENT, and TOP_ALIGNMENT; page 5 of 13 JMenuItem: "setAlignmentX,"

"setAlignmentY", inherited from JComponent (page 19, 20 of 42)) and need not overlap

(Fig. 7.14, 7.15.)

Claim 11: <u>Piroumian</u> discloses apparatus for decoding according to claim 2, further

comprising means for decoding for the selectable display data of the first menu items

associated display positions (pg. 227, top code block directs the order of display, and

hence the positions), and means for decoding for the non-selectable display data of the

second menu items associated display positions (pg. 227, menu1.addSeparator()),

wherein the display positions of the first and second menu items comprise a horizontal

address and a vertical address (inherent feature as indicated by: page 2 of 42:

"BOTTOM_ALIGNMENT, CENTER_ALIGNMENT, LEFT ALIGNMENT, RIGHT

ALIGNMENT, and TOP_ALIGNMENT; page 5 of 13 JMenuItem: "setAlignmentX,"

"setAlignmentY", inherited from JComponent (page 19, 20 of 42)) need not overlap (Fig.

7.15.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Piroumian in view of jlGui (jlGui, Java Music Player, version 2.1.1, April 1, 2002;

http://web.archive.org/web/20021012174158/www.javazoom.net/jlgui/sources.hrml.)

Claim 5, 12: Piroumian discloses the method according to claim 1. However, Piroumian

does not explicitly disclose wherein sound data are associated to a state of a menu

button, the sound data and the menu data segment being read from a single storage

medium and being played back upon entry of the button into the associated state. jlGui

discloses a Java Applet, wherein sound data are associated to a state of a menu button,

the sound data and the menu data segment being read from storage medium and being

played back upon entry of the button into the associated state (pg. 1.) Therefore, it

would have been obvious to one having ordinary skill in the art at the time the invention

was made to combine the teaching of Piroumian and jlGui so as to provide sound data

associated with a menu button for playback. One would have been motivated to

combine the teaching of jlGui into Piroumian because jlGui uses the same Java

Foundation Classes (JFC) as those used in examples in <u>Piroumian</u> without expounding

on further the capabilities allowed by JFC (javax.sound package) as is shown in <u>jlGui</u>.

<u>jlGui</u> does not explicitly disclose wherein the sound data and menu data segment

are read from a single storage medium. The Examiner takes Official Notice that

personal computers with a single hard disk drive are old and well known in computing

arts. Therefore, it would have been obvious to one having ordinary skill in the art at the

time the invention was made to utilize a personal computer having a single hard disk

drive so as to store all personal, operating system, and application data thereon,

(including sound and menu data) so as to meet the demands of users wanting to play

back stored music files on their personal hard disk drives.

Claim 6: <u>Piroumian</u> discloses the method according to claim 1. However, <u>Piroumian</u>

does not explicitly disclose wherein the menu controls playback of audio-visual data, the

audio-visual data stored on a single storage medium with the menu data segment. <u>jlGui</u>

discloses a Java Applet, wherein the menu controls playback of audio-visual data stored

on the storage medium as the menu data segment (pg. 1, media controls and a

visualizer (spectrograph.)) Therefore, it would have been obvious to one having ordinary

skill in the art at the time the invention was made to combine the teaching of <u>Piroumian</u>

and <u>jlGui</u> so as to provide audio-visual data controlled by menu controls. One would

have been motivated to combine the teaching of <u>jlGui</u> into <u>Piroumian</u> because <u>jlGui</u> uses

the same Java Foundation Classes (JFC) as those used in examples in <u>Piroumian</u>

without expounding on further the capabilities allowed by JFC (javax.sound package) as

is shown in jlGui.

jlGui does not explicitly disclose wherein the audio-visual data and menu data

segment are read from a single storage medium. The Examiner takes Official Notice

that personal computers with a single hard disk drive are old and well known in

computing arts. Therefore, it would have been obvious to one having ordinary skill in the

art at the time the invention was made to utilize a personal computer having a single

hard disk drive so as to store all personal, operating system, and application data

thereon, (including audio-visual and menu data) so as to meet the demands of users

wanting to play back stored movie files on their personal hard disk drives.

(10) Response to Arguments

Claim 1, Argument 1:

Appellant argues that Piroumian does not show, "at least first data defining

whether the menu item is selectable" as recited in claim 1. Appellant argues that

enablement of a button cannot be construed as affecting the selectability of that button.

The Examiner respectfully disagrees.

The claims as recited and the rejection based on Piroumian are with respect to

"menu items" and not "buttons" as argued by the Appellant. Piroumian discloses a

method for setting a state of a menu item as enabled or disabled - a Boolean variable.

The central role of a menu item is its selection. Therefore, a menu item that is enabled is selectable and a menu item that is disabled is unavailable for selection.

Claim 1, Argument 2:

Appellant argues that <u>Piroumian</u> does not show "non-selectable and visible display data, wherein the second menu items have graphic representation data associated" as recited in claim 1. Appellant argues that the element *menu1.addSeparator()* is not shown in Figure 7.15. Appellant further argues that this separator element is an indication to the code interpreter where to separate code of the higher level menu from the code for the nested menu, and as such does not in and of itself provide visible display data. The Examiner respectfully disagrees.

The element *menu1.addSeparator()* is visible both in Fig. 7.14 and 7.15 of <u>Piroumian</u>, and likewise it is shown in Fig. A and B, of Appellant's Appeal Brief. This separator element, as the name implies is a separator graphic shown as a visible thin line between menu items, such as the line between "Menu Item 3" and "Nested Menu" of Fig. 7.14, and "Check Box 3" and "Radio 1" and between "item1", and "item3" in Fig. A, of Appellant's Appeal Brief. Appellant's argument that this separator element somehow separates levels of menu is not persuasive, especially in light of the example included in Appellant's Brief, wherein similar menu items (item1, item2, and item3) of equal "hierarchy" are shown to be partitioned by the same *menu.addSeparator()* (Appellant's Brief, pg 9, line 10.)

Claim 1, Argument 3:

Appellant argues that <u>Piroumian</u> does not show "selectable and invisible menu items" as recited in claim 1. Appellant argues that the No-argument constructor (<u>Piroumian</u>, top of page pg. 232) as used by the JMenuItem(), though constructs a menu item without icon or a text and appears to be empty, is nonetheless visible. The Examiner respectfully disagrees.

Claim 1 recites that the third menu items (selectable and invisible) "have no associated graphic representation." The No-argument constructor as used by the JMenuItem() creates a menu item with no defined text or icon, and if added to a menu would look as an empty space (see Fig. A and B of Appellant's Brief.) An empty space cannot be construed as an "associated graphic representation" but merely as a background of a pull-down menu.

Claim 1, Argument 4:

Appellant argues that <u>Piroumian</u> does not show "wherein the third menu items are menu buttons that are automatically activated upon selection" as recited in claim 1. Appellant argues that the method for setting Accelerator keystrokes for menu items is for "accelerating" and not for selection with a cursor. The Examiner respectfully disagrees.

Claim 1 does not recite that the selection must be performed by a cursor. The setAccelerator method applies equally to all menu items as indicated at the top of page 232: "JMenuItem Constructors and Methods." The description of this method further

indicates (bottom of page 232) that the key combination "is equivalent to the user

selecting the menu item."

Claims 8 and 11, Argument 5:

Appellant argues that <u>Piroumian</u> does not show "the first and the second menu

items have associated display positions comprising a horizontal address and a vertical

address" as recited in claim 8. Appellant argues that this limitation is missing from the

reference because the Examiner states that it is an inherent feature in <u>Piroumian</u>, and

therefore <u>Piroumian</u> does not anticipate claim 8. The Examiner respectfully disagrees.

MPEP 2131.01, paragraph III, indicates that an extrinsic evidence may be used

to make clear that the missing descriptive matter is necessarily present in the main

reference, and it would be so recognized by persons of ordinary skill. Claim 8 recites

that the menu items have *associated* display positions comprising a horizontal and

vertical addresses. Supporting extrinsic evidence in the form of JAVA API (pages 1-42)

was used to make clear that the associated display positions of the menu items

comprise of horizontal and vertical addresses.

Claims 5, 6, and 12, Argument 6:

Appellant argues that <u>Piroumian</u> does not show "the sound data and the menu

data segment being read from a single storage medium" as recited in claim 5. Appellant

argues that this limitation should only mean that both data are read from the *same*

single storage medium. The Examiner respectfully disagrees.

The Official Notice taken by the Examiner stipulates that personal computers with a single hard disk drive are old and well known in computing arts. Such that a combination of jlGUI and <u>Piroumian</u>, which both store their respective data in some storage medium, would in combination with a personal computer having a single hard disk drive would storage such on that single hard disk drive. Such a combination would be motivated by demands of users wanting to store all their data on personal hard disk drives, as opposed to other storage mediums.

Argument 7:

Appellant argues that the Examiner failed to provide a sufficiently complete and contiguous rendering of the prior art references. The Appellant argues that a request was made (see Applicant's Argumens/Remarks, dated 5/12/2008), in relation to the <u>Piroumian</u> reference, to which the Examiner has not made any response. The Examiner respectfully disagrees.

In response to Appellant's request on 5/12/2008, the Examiner had submitted on 8/6/2009, larger excerpts (NPL document dated 8/16/2009, 19 pages) from the <u>Piroumian</u> reference so as to provide the Appellant with background and context as requested.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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10/16/2009

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